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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,238	08/13/2001	Stephen F. Gass	SDT 315	8811

27630 7590 12/02/2004

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EXAMINER
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ASHLEY, BOYER DOLINGER

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/929,238

Applicant(s)

GASS ET AL.

Examiner

Boyer D. Ashley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/8/18/04; 4/24/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> .           |

Continuation of Attachment(s) 6). Other: 1449's-4/17/04;3/7/04;2/12/04;2/4/04;11/16/03;8/16/03;8/10/03;3/15/03;9/9/02.

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## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/12/04 has been entered, wherein claims 1-8 and 19-29 were canceled and claim 30 was added.

### ***Inventorship***

2. In view of the papers filed 10/12/04, the inventorship in this nonprovisional application has been changed by the deletion of David S. D'Ascenzo and Davis A. Fanning.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney, or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 9 and 30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 25-27 of copending Application No. 09/929,242. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in claim terminology but encompass the same subject matter, that is, claims 1 and 25-27 of 09/929,242 anticipates claims 9 and 30.

Claims 1 and 25-27 of 09/929,242 discloses the same invention as claimed including a support structure (line 2 of claim 9; line 2 of claim 30; and line 4 of claim 25); a swing arm (line 3 of claim 9; line 3 of claim 30; and lines 5-7 of claim 25); a rotatable blade (line 4-5 of claim 9; line 4-5 of claim 30; and lines 5-7 of claim 25); a handle (lines 6-7 of claim 9; lines 6-7 of claim 30; and lines 8-9 of claim 25); a motor (line 8 of claim 9; line 8 of claim 30; and line 10 of claim 25); a detection system for detecting contact (lines 9-10 of claim 9; lines 9-10 of claim 30; and lines 11-13 of claim 25 and lines 1-4 of claim 26); and a brake mechanism adapted to stop rotation (lines 11-13 of claim 9; lines 11-12 of claim 30 and lines 11-13 of claim 25 and lines 1-4 of claim 26).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 9 and 30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 8 of

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copending Application No. 10/643,296 in view of Brundage et al., U.S. Patent 4,934,233.

Claims 1 and 8 discloses the invention substantially as claimed in claims 9 and 30 except for the handle associated with the swing arm and adapted so that a user may pivot the swing arm and blade into the cutting zone; however, Brundage et al. discloses that it is old and well known in the miter saw art to use handles associated with the swing arm of a miter saw for the purpose of facilitating safe movement of the cutting blade into the cutting zone. Therefore, therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a handle associated with the miter saw of claims 1 and 8 in order to facilitate safe movement of the cutting blade into the cutting zone.

This is a provisional obviousness-type double patenting rejection.

6. Claims 9 and 30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 15 of copending Application No. 10/215,929 in view of Brundage et al., U.S. Patent 4,934,233.

Claims 1 and 15 discloses the invention substantially as claimed in claims 9 and 30 except for the support structure having a cutting zone; the handle associated with the swing arm and adapted so that a user may pivot the swing arm and blade into the cutting zone; and a swing arm above and pivotally attached to the support structure; however, Brundage et al. discloses that it is old and well known in the miter saw art to use support structure with cutting zones, handles associated with the swing arm of a

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miter saw, and swing arms above and pivotally attached to the support structure for the purpose of facilitating safe movement of the cutting blade into the cutting zone.

Therefore, therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a support structure, handle and swing arm with the miter saw of claims 1 and 8 in order to facilitate safe movement of the cutting blade into the cutting zone.

This is a provisional obviousness-type double patenting rejection.

7. Claims 9 and 30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 19 of copending Application No. 10/100,211 in view of Brundage et al., U.S. Patent 4,934,233.

Claims 1 and 19 discloses the invention substantially as claimed in claims 9 and 30 except for the handle associated with the swing arm and adapted so that a user may pivot the swing arm and blade into the cutting zone; however, Brundage et al. discloses that it is old and well known in the miter saw art to use handles associated with the swing arm of a miter saw for the purpose of facilitating safe movement of the cutting blade into the cutting zone. Therefore, therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a handle associated with the miter saw of claims 1 and 19 in order to facilitate safe movement of the cutting blade into the cutting zone.

This is a provisional obviousness-type double patenting rejection.

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8. Claims 9 and 30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27, 29 and 30 of copending Application No. 09/676,190 in view of Brundage et al., U.S. Patent 4,934,233.

Claims 27, 29 and 30 disclose the invention substantially as claimed in claims 9 and 30 except for the handle associated with the swing arm and adapted so that a user may pivot the swing arm and blade into the cutting zone; however, Brundage et al. discloses that it is old and well known in the miter saw art to use handles associated with the swing arm of a miter saw for the purpose of facilitating safe movement of the cutting blade into the cutting zone. Therefore, therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a handle associated with the miter saw of claims 27, 29, and 30 in order to facilitate safe movement of the cutting blade into the cutting zone.

This is a provisional obviousness-type double patenting rejection.

9. Claims 9 and 30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 39 and 40 of copending Application No. 09/676,190. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in claim terminology but encompass the same subject matter, that is, claims 39 and 40 of 09/676,190 anticipate claims 9 and 30.

Claims 39 and 40 of 09/676,190 disclose the same invention as claimed including a support structure (line 2 of claim 9; line 2 of claim 30; and line 2 of claim 39);



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a swing arm (line 3 of claim 9; line 3 of claim 30; and line 3 of claim 39); a rotatable blade (line 4-5 of claim 9; line 4-5 of claim 30; and lines 4-6 of claim 39); a handle (lines 6-7 of claim 9; lines 6-7 of claim 30; and lines 7-8 of claim 39); a motor (line 8 of claim 9; line 8 of claim 30; and line 9 of claim 39); a detection system for detecting contact (lines 9-10 of claim 9; lines 9-10 of claim 30; and lines 10-11 of claim 39); and a brake mechanism adapted to stop rotation (lines 11-13 of claim 9; lines 11-12 of claim 30 and lines 12-15 of claim 39 and lines 1-4 of claim 40).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 9 and 30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15 of copending Application No. 10/052,274 in view of Brundage et al., U.S. Patent 4,934,233.

Claim 15 discloses the invention substantially as claimed in claims 9 and 30 except for the handle associated with the swing arm and adapted so that a user may pivot the swing arm and blade into the cutting zone; however, Brundage et al. discloses that it is old and well known in the miter saw art to use handles associated with the swing arm of a miter saw for the purpose of facilitating safe movement of the cutting blade into the cutting zone. Therefore, therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a handle associated with the miter saw of claim 15 in order to facilitate safe movement of the cutting blade into the cutting zone.

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 9 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brundage et al., U.S. Patent 4,934,233, or Suzuki et al., U.S. Patent 5,791,224, in view of Lokey, U.S. Patent 3,785,230, and Yoneda, U.S. Patent 4,117,752.

Brundage et al. and Suzuki et al. both disclose the invention substantially as claimed except for the detection system adapted to detect contact between the blade and a person; and a brake mechanism adapted to stop rotation of the blade upon detection by the detection system of contract between the blade and the person. However, Lokey discloses that it is old and well known in the circular saw art to use detection systems and brake mechanism with circular cutting tools for the purpose of detecting unsafe conditions and then braking the cutting tool such that injury to the user is prevented. Yoneda discloses that it is old and well known in the art to use detections that detect contact between a user and a blade for the purpose of preventing injury to a user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a detection system and braking mechanism, as taught by Lokey and Yoneda, with the miter saws of Brundage et al. and Suzuki et al., in order to prevent injury to a user.

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***Response to Amendment***

13. The declaration under 37 CFR 1.132 filed 10/12/04 is insufficient to overcome the rejection of claims 9 and 30 based upon Lee in view of Yoneda as set forth in the last Office action because claims 9 and 30 are not currently rejected under Lee in view of Yoneda.

It should further be noted that declaration fails to set forth any facts; is not germane to the new grounds of rejection; and the showing is not commensurate scope with the claims. In this case, the declaration only gives the opinion of the applicant as to why the invention is important or rather why it might be popular with users.

***Response to Arguments***

14. Applicant's arguments with respect to claims 9 and 30 have been considered but are moot in view of the new ground(s) of rejection.

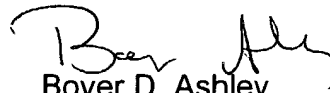
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 571-272-4502. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Boyer D. Ashley  
Primary Examiner  
Art Unit 3724

BDA  
November 28, 2004